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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/007,105	12/04/2001	William A. Banks	2001P07389 US01	3627

7590 07/20/2006
Elsa Keller
Intellectual Property Department
Siemens Corporation
186 Wood Avenue South
Iselin, NJ 08830

EXAMINER

CUFF, MICHAEL A

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 07/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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10/007105

EXAMINER

ART UNIT

PAPER

20060717

DATE MAILED:

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Commissioner for Patents

Appellant's reply brief, filed 7/13/06, has been received and considered.

See next page for examiner's response to appellant's remarks.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Cuff whose telephone number is (571) 272-6778. The examiner can normally be reached on 8:00 to 5:30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael Cuff
July 17, 2006

Michael Cuff 7/17/06
MICHAEL CUFF
PRIMARY EXAMINER

Response to appellant's remarks

Appellant asserts that claims 1-25 do not use "intended use" phrases. The examiner does not concur. For example, in claim 1, "a data processor for receiving product information". "for receiving product information" is an intended use of the data processor and does not define discrete physical structures or materials.

The applicant has chosen the statutory class of an "apparatus" or product claim to define the invention. Claim limitations describing what the invention does carry little patentable weight. The examiner has used the cited MPEP section below for guidance in addressing the substantive arguments of the appellant. (underlining emphasis added by examiner.)

From MPEP 2106 II, C:

"Office personnel must first determine the scope of a claim by thoroughly analyzing the language of the claim before determining if the claim complies with each statutory requirement for patentability. See *In re Hiniker Co.*, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998) ("[T]he name of the game is the claim.").

Office personnel should begin claim analysis by identifying and evaluating each claim limitation. For processes, the claim limitations will define steps or acts to be performed. For products, the claim limitations will define discrete physical structures or materials. ...

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

- (A) statements of intended use or field of use,
- (B) "adapted to" or "adapted for" clauses,
- (C) "wherein" clauses, or
- (D) "whereby" clauses.

This list of examples is not intended to be exhaustive. >See also MPEP § 2111.04.<"